REMARKS-General

The Applicant is in receipt of the final Office Action (O.A) dated April 7, 2004. In the O.A., the Examiner objects to claims 4, 8, 9, 10, 11, 12, 13, 17, and 20 as being dependent upon a rejected base claim, but states that these claims would be allowable if rewritten in independent form including all limitations of the base and intervening claims. Claims 1, 2, 3, 5, 6, 7, 14, 15, 18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts (U.S. Patent No. 6,065,002, filed 10/31/1996) in view of Reed (U.S. Patent No. 6,546,399, filed 2/28/1994). Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts, Reed, and Slotznick (U.S Patent No. 5,983,200). The Office Action Summary places Claim 12 among those that were rejected, although the narrative of the Office Action places claim 12 among those that were objected to.

The applicant respectfully disagrees with the grounds for rejection of these claims, and requests reconsideration of the grounds for rejection.

Many of these rejections appear to be based on a misinterpretation of the use of the terms "age information" and "age-event information," which appear in the independent claims 1, 14, and 21 and are reproduced here:

> . . .wherein said age information comprises information related to the age of a first individual and said age-event information comprises information regarding an event that occurred in the life of a second individual when said second individual was at an age bearing a pre-defined mathematical relationship to the age of said first individual.

All of these rejections are also predicated upon combining Knotts with Reed, such that the methods described in Knotts are used to calculate the age of both the first and second individuals as of a given date, and such that the database in Reed may be used to look up information about events in the life of a historical figure. Thus, it would appear that the main argument in favor of obviousness is that the Examiner can determine (after referencing the specification of the current invention), how various elements described in the specification of the current invention may be combined to perform the steps of the invention, as described in the independent claims. If it were not possible to combine the individual steps as described in the independent claims, however, the invention would not be enabled. Thus, by the logic of the O.A., any invention that relied upon a sequence of steps, each of which is individually shown (or hinted at) in the prior art, would be considered obvious. This clearly is not correct. Thus, while the combination of Knotts and Reed does not arrive at the claimed invention, even if combinations of Knotts and Reed arrived at the present invention, it would be inappropriate to consider these combinations in an obviousness determination.

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a) Knotts and Reed Do Not Contain Any Justification or Motivation to Support Their Combination to Arrive at the Present Invention.

With regard to the proposed combination of Knotts and Reed, it is well known that in order for any prior art references themselves to be validly combined for use in a prior art section 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983):

> "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law [here the PTO]."

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988):

> "Where prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself. . . . *Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis applied.]

In line with these decisions, the Board stated in Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993):

> "In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. . . . That which is within the capabilities of one skilled in the art is not synonymous with obviousness. . . . That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. . . . Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' . . . Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

The O.A. supports the proposed combination of Knotts and Reed with the statement "The motivation is that the combination of Knotts and Reed is advantageous where Knotts calculates the age that has a relationship of both first and second individual at a point in time using age function" (p. 4).

Identification of an advantage associated with the present invention is not the same as describing the motivation that would cause a person with ordinary skill to combine Knotts and Reed to achieve that advantage. The O.A. noted that the present invention produces an advantage ("is advantageous"). Applicant submits that the fact

that the present invention produces advantages militates in favor of Applicant because it proves that the combination produces new and previously unrealized results, and hence, is unobvious.

As stated in the above Levengood case:

> "That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention."

Applicant therefore submits that combining Knotts and Reed is not legally justified and is therefore improper. Thus, Applicant submits that the rejection on these references is also improper and should be withdrawn. Applicant respectfully requests, that if the claims continue to be rejected on any combination of references, that the Examiner include an explanation, in accordance with MPEP 706.02, Ex parte Clapp, 27 USPQ 972 (BPAI 1985), and Ex parte Levengood, *supra*, of a "factual basis to support his conclusion that it would have been obvious" to make the combination.

b) Knotts and Reed are individually complete, and solve different problems from the present invention.

Because Knotts and Reed each describe complete inventions (Knotts related to a simplified interface for database connectivity, and Reed related to providing a multimedia

search system appropriate for presenting data in an encyclopedia), each reference further lacks motivation for any combinations with other inventions. Each reference is complete and functional in itself, so there would be no reason to use parts from, or add or substitute parts to, any reference.

Moreover, applicant's invention solves a different problem than the references, and such different problem is recited in the claims (In re Wright, 6 USPQ2d 1959 (1988)). In particular, the present invention provides "a user with age-event information corresponding to . . . age information" (Claim 1), a problem clearly not addressed by any of the cited prior art.

c) The present invention yields advantages not appreciated by Knotts or Reed.

In the O.A., the Examiner readily appreciated the additional advantage that the present invention provides to a reader, stating that combining Knotts and Reed to arrive at the present invention is "advantageous." Nothing in either Knotts or Reed suggests that the advantages of the current invention may be obtained through any combination of inventions involving either of these references.

d) Nobody has attempted to combine Knotts and Reed in the manner suggested by the Examiner.

Although combination of Knotts and Reed does not arrive at the claimed invention, Applicant is unaware of any existing combination of these references to arrive

at any invention. Moreover, if the present invention were in fact obvious due to these or any combination of prior art references, because of its advantages, those skilled in the art surely would have implemented it by now. That is—the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Discussion of individual claim rejections.

In rejecting claim 1, the O.A. asserts that

> Reed teaches c) providing an output signal comprising age-event information corresponding to said age information (see column 17, line 66-column 18, line 1); wherein said age information comprises information related to the age of a first individual and said age-event information comprises information regarding an event that occurred in the life of a second individual when said second individual was at an age bearing a pre-defined mathematical relationship to the age of said first individual (see column 18, lines 1-17) (O.A. pages 3-4).

Rejection of claims 7, 14, 18, 21 and 22 relies on citation of these same passages in Reed. The cited passages in Reed describe retrieval of information by activating a major event box, such as "Discovery and Exploration," which lists historical events in a database during a time period associated with the major event (in Reed's example, from 1490-1625). The user may then select an event from that list, such as "1492-Christopher Columbus discovers the New World" to receive additional information about Columbus, or to identify additional articles about Columbus. The O.A. does not make clear, in this

example, who the first individual of claim 1 is purported to be. Since only one individual (Columbus) is referred to in this passage, it would be impossible for another individual (based on the combination of Knotts and Reed) to be at an age bearing a pre-defined mathematical relationship to the age of Columbus at the time the New World was discovered. Moreover, there is no evidence that information is present in Reed's database to allow calculation of Columbus' age at the time the New World was discovered (or that in constructing the database, Reed contemplated calculating that age), to permit comparison of that age with the age of another individual. In addition, neither Knotts nor Reed teaches use of a pre-defined mathematical relationship to compare the ages of two individuals. Thus, combination of Knotts and Reed does not arrive at the claimed invention. To practice the claimed invention, one would need to calculate an age of a first individual, and identify in a database events that occurred while historical figures (second individuals) were at an age related to the age of the first individual. Neither Reed nor Knotts provides a means to do that.

With respect to claims 2 and 15, the O.A. states that Reed teaches "the output signal comprises a celebrity ageliner, wherein said celebrity ageliner names a celebrity and describes a historical event in the life of an individual that occurred when said individual was the age of said celebrity on said date (column 17, lines 33-67 and column 18, lines 1-17)"

The cited passage from Reed again describes (in somewhat more detail) how data regarding historical events may be accessed using Reed's database. In this description, information about historical events is accessed with reference to a timeline, which restricts the look-up of historical events to a specified period of time in history.

According to the O.A., in Reed, Columbus is the celebrity. However, there exists no means to determine who the other individual is, how information about historical events in the life of that individual would be identified, or for that matter, correlated with the age of Columbus on any given date.

With respect to claim 3, the O.A. asserts that Knotts teaches the input signal comprises age information relating to a target individual, and the output signal comprises age-event information customized for said first individual, and the output signal includes a reference to said first individual (see Fig. 5 and col. 6, lines 18-23). In rejecting claim 1, the O.A. states that "Knotts does not explicitly teach c) providing an output signal comprising age-event information. . .." Fig. 5 and col. 6, lines 18-23 do not provide any information that can be construed as age-event information within the definition of claim 1. Thus, Knotts does not teach the limitations of claim 3.

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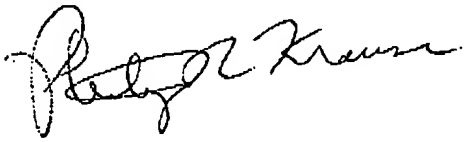
Conclusion and Request for Interview

For all of the above reasons, the specification and all claims are in proper form, and the claims all define patentably over the prior art. Therefore, this application is in condition for allowance, which action is respectfully solicited. In addition, the Applicant requests a face-to-face interview with the Examiner, in order to more completely discuss the claims and the relevance of the cited prior art.

Very Respectfully,



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Attachment: USPTO form PTOL 413A

Certificate of Facsimile Transmission

I certify that on the date below, I will fax this communication and attachments, if any, to Group 2172 of the Patent and Trademark Office at the following number: 703-872-9306.

Date: 6/7/2004

Inventor's Signature